

The Examiner has also indicated that the application contains claims to two patentably distinct species, namely Group A (Fig. 2A and 2B), on which generic claim 1 and species claims 2-6, 8-10 read, and Group B (Fig. 4A and 4B), on which on which generic claim 1 and species claim 7 read.

Request for Reconsideration and Withdrawal of the Restriction Requirement Between Inventions I and Invention II

Applicant requests reconsideration and withdrawal of the restriction requirement because the Examiner has not made a prima facie showing that Inventions I and II, as claimed, are independent or distinct.

In order to meet its burden of establishing a prima facie basis for restriction, the Patent Office must provide (1) reasons why the inventions as claimed are independent or distinct, MPEP 806; and (2) the reasons for insisting upon restriction between the inventions. MPEP 808. It is respectfully submitted that the examiner has not satisfied either of these criteria with regard to Inventions I and II.

a) The Examiner has not made a prima facie showing that Inventions I and II are independent and distinct as claimed

35 U.S.C. § 121 provides, "If two or more independent and distinct inventions are claimed in one application, the Commissioner *may* require the application to be restricted to one of the inventions." (emphasis added). Restriction is thus discretionary, *not* required.

The Patent Office interprets the term "independent" to mean that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation, or effect. MPEP 802.01. The Patent Office interprets "distinct" to mean that two or more inventions are (1) capable of separate manufacture, use or sale as claimed, and (2) patentable over each other. MPEP 802.01. Where, as disclosed in the application, the several inventions claimed are related, and such related

inventions are not patentably distinct as claimed, restriction is never proper. MPEP 806.05; 808.02.

In asserting grounds for the restriction requirement, the Examiner relies on MPEP § 806.05(h) concerning distinctness between products and processes of using. Applicant respectfully suggests that reliance on § 806.05(h) is misplaced, because the term “product” does not refer to apparatuses, such as the drinking cup apparatus claimed in claims 1-10. Applicant suggests that the restriction requirement should be based on MPEP § 806.05(e), which provides that a process and an *apparatus* for its practice can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another and materially different process. MPEP 806.05(e). The burden is on the Examiner to provide reasonable examples that recite material differences. *Id.* Regardless of whether the standard set forth in MPEP § 806.05(e) or (h) is used, the Examiner has not met the Commissioner’s burden of establishing a prima facie case that inventions I and II, as claimed, are independent and distinct from one another.

The Examiner’s example consists of the following statement: “In the instant case, the drinking cup can be used in a materially different process of holding pencils.” (February 19, 2002 Office Action, Paragraph 2). The Examiner’s example cannot be considered a reasonable example that recites material differences. In claims 11-17 (Invention II), applicant is merely claiming a method of using the apparatus of claims 1-10 (Invention I). The apparatus of claims 1-10 and the methods of claims 11-17 both provide a drinking container for assisting disabled persons in drinking fluids by reducing the degree of tilt necessary to drain the fluid from the container, thus permitting consumption without requiring a user to tilt one’s head. It is unclear how the apparatus of claims 1-10 can be used to hold pencils when, *as claimed*, the apparatus holds fluids and further permits drainage of the held fluids with a reduced degree of tilt. The

Examiner is neglecting to consider the invention as claimed, and appears to be importing additional properties (i.e. storage of solid materials) that are not even mentioned in applicant's patent application.

Under the circumstances, the Patent Office has not met its burden of demonstrating that the process as claimed can be practiced by another materially different apparatus or by hand, as required by MPEP § 806.05(e) (or, alternatively, that the "product" as claimed can be used in a materially different process of using the product, as required by MPEP § 806.05(h)). Accordingly, the Patent Office has not met its burden of establishing that Invention I and II are independent and distinct inventions.

b) The Examiner has not provided reasons for insisting on restriction between Inventions I and II

If the Patent Office contends that related inventions are distinct under the criteria of MPEP 806.05, the Patent Office must *also* explain why the distinct inventions must be restricted on the basis of (a) separate classification, (b) separate status in the art, or (c) a different field of search. MPEP 808.02. In the present case, the Examiner merely states that "[b]ecause these inventions are distinct ...and have acquired a separate status in the art as shown by there different classification, restriction for examination purposes as indicated are proper." (Paragraph 3 of the February 19, 2002 Office Action). This statement does not address the criteria of MPEP 808.02, and does not provide the required explanation as to why the allegedly distinct inventions must be restricted.

Moreover, the Examiner has classified Invention II in class 604. (Paragraph 1 of the February 19, 2002 Office Action). Class 604 is defined as "Surgery." While class 604 does include subclass 78, "Drinking Cup," it would be necessary to search both classes for either Invention I or Invention II, assuming the classification is correct. Thus, there would not be an increased burden on the Patent Office if the restriction requirement

were withdrawn. The statement that the inventions have acquired a separate status in the art is unsupportable because claims 11-17 merely claim methods for using the apparatus of claims 1-10. Accordingly, the search required for Invention I would be the same as the search required for Invention II.

Additionally, if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions. MPEP 803. In this case, examination of Inventions I and II can clearly be made without serious burden on the examiner, because Invention II merely claims a process for using the apparatus of Invention I.

Conclusion

Because the February 19, 2002 office action does not set forth reasons why the Inventions I and II as claimed are independent or distinct and the reasons for insisting upon restriction, the Patent Office has not met its burden of establishing a prima facie basis for restriction. Accordingly, applicant requests withdrawal of the restriction requirement between Inventions I and II, and that examination proceed forward on claims 1-17.

Respectfully submitted,



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